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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/486,000 06/08/95 COOPER

J G: /7434CIP

RAO.S EXAMINER

26M1/0926

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ART UNIT PAPER NUMBER

2603

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DATE MAILED:

09/26/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

[See Attachment]

Office Action Summary

Application No.

08/486,000

Applicant(s)

J. CARL COOPER

Examiner

Seema S. Rao

Group Art Unit

2603



☒ Responsive to communication(s) filed on Jun 8, 1995

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☒ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The claims are objected to because they lack a proper introduction. The present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim", "The invention claimed is" (or the equivalent). MPEP § 608.01(m).

Claim Rejections - 35 USC § 112

2. Claims 14-24 and 28-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an "access system" known to the inventor, does not reasonably provide an enablement for the "access system", as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the "access system" the invention commensurate in scope with these claims.

A single means, "the improvement of means to", as in claims 14, 18, 19, 21, and 28, which covered every conceivable means for achieving the stated purpose is non enabling for the scope of the claim because the specification disclosed at most only those means known to the inventor. (Refer to 2164.08(a) Single Means Claim [R-1]

>A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 218 USPQ

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195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held non enabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in Fiers v. Sugano, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim. <

3. Claims 1-9, 20, and 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, the statement, "programs transmitted compresses form on a transmission channel", is unclear. The statement should be corrected to --programs transmitted in a compresses form.--, if that is the intent.

In claim 6, lines 2 and 3, the statement, "the transmission media including program identification data", is vague. What is meant by a transmission media including program identification data? It should be corrected to --the programs including program identification data--, if that is the intent.

In claim 20, lines 2 and 3, the statement, "the passage of time", is confusing. The passage of time is compared to an event, which is confusing.

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In claim 33, lines 2-4, the statement, "the improvement of a data manager and means for said data manager to control.." is vague. The improvement of a data manager is not clear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-6, 8-12, 25, 27, and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan (U.S. 5,524,051).

The reference, Ryan, discloses an access system for multiple programs in a compressed form, as in claim 1, in Fig. 1. A recording medium, as in claims 1 and 2, is disclosed in column 2, lines 31 and 32. Selecting a particular program, as in claim 1, is disclosed in column 4, lines 36-56. Decompressing the selected program, as in claim 1, is disclosed in Fig. 1, represented by 39. Storing programs in a compressed form, as in claim 3, is disclosed in column 2, line 32. A means for accessing program information, as in claim 4, reads on the conditional access circuitry, as shown in The

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Fig. 1, element 16. A data manager, as in claim 5, reads on the user interface (column 2, lines 32-36).

The reference discloses transmitting program identification data, accessing, and processing the program identification data, as in claim 6, in column 4, lines 27-56. A data manager, as in claims 8 and 9, reads on the user interface (column 2, lines 32-36). The reference, Ryan, discloses an access system for multiple programs in a compressed form, as in claim 10, in Fig.1. A recording medium, as in claim 10, is disclosed in column 2, lines 31 and 32. Selecting a particular program, as in claim 10, is disclosed in column 4, lines 36-56. Decompressing the selected program, as in claim 10, is disclosed in Fig. 1, represented by 39. An optical disk for the program storage, as in claim 11, is disclosed in column 3, lines 55-59. A computer memory, as in claim 12, is disclosed in column 3, lines 52 and 53.

The reference, Ryan, discloses an access system accessing multiple programs in compressed form, as in claim 25, in Fig.1. A storage media, as in claims 25, is disclosed in column 2, lines 31 and 32. Selecting a particular program, as in claim 25, is disclosed in column 4, lines 36-56. Decompressing the selected program is disclosed in Fig. 1, represented by 39. A means for accessing program information, as in claim 4, reads on the conditional access circuitry, as shown in The Fig. 1, element 16. A data manager, as in claim 27, reads on the user interface (column 2, lines 32-36).

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The reference discloses the processing of the program identification data, as in claim 27, in column 4, lines 27-56. The reference also discloses an access system, as in claim 33, for controlling access to the information, in Fig.1, represented by access circuitry and the user interface. A data storage, as in claim 34, reads on the memory, represented by 28 in Fig. 1. The program information relative to the multiple channels of information and addition of other services, as in claims 35 and 36, are disclosed in column 4, lines 27-56.

6. Claims 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Dean et al. (U.S. 5,303,326) .

The reference, Dean et al., discloses an access system having a storage capability of overwriting previously stored material, as in claims 14, 18, and 19, in Fig. 1, represented by "PC hard disk". Consideration of available storage; time of storage; and priority of the user, as in claims 15, 16, 17, and 20 are inherent to a computer system.

7. Claim 28 is rejected under 35 U.S.C. 102(e) as being anticipated by Yoshioka et al. (U.S. 5,483,506) .

The reference, Yoshioka et al., discloses an access system having a storage area and means to bypass the storage area so as to select real time reproduction in

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Fig. 1. Switch 5, in the Figure reads on the means to bypass the storage area, as in claim 28.

8. Claims 29, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Raogalski (U.S. 5,159,636) .

The reference, Yoshioka et al., discloses an access system with a decompression decoder and an artifact modifier circuit, as in claim 29, in Fig. 1. Deactivating the frequency converter, as in claims 31 and 32, is disclosed in Fig. 1, represented by a dashed line 25.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Schiffman (U.S. 3,786,195).

The reference, Schiffman, discloses an access system for reproducing programs, with different length than the original recorded program, in the Abstract.

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffman (U.S. 3,786,195) as applied to claim 21 above, and further in view of Yoshioka et al. (U.S. 5,483,506).

The reference, Schiffman, substantially discloses all of the limitations of claims 22-24, but does not disclose a program interrupt, as in claim 22; a program terminating at the original termination time, as in claim 23; an automatic means, as in claim 24. The reference, Yoshioka et al., discloses a program interruption of the access to the programs and an automatic playback of the program in the Abstract. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the playback system by shortening length of the playback, as disclosed by Schiffman, to terminate at the original termination time, during the interrupt and the playback period of Yoshioka et al., to make the system adaptive to user requirements.

13. Claims 7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (U.S. 5,524,051).

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The reference, Ryan, discloses substantially all of the limitations of claims 7 and 26, but does not disclose delaying the programs to allow processing of the program identification data. The reference, however discloses decryption of the data prior to the program storage, as shown in the Fig. 1, represented by elements 14-28. From the Fig. It is obvious that the program data is delayed until the decryption of the program related data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the decryption of the signal, as disclosed by Ryan, by delaying the program data allowing the processing of the program identification data in order to make the system reliable and secured.

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (U.S. 5,524,051) applied to claims 10 and 29 above, and further in view of Barrett (U.S. 5,287,420)

The reference, Ryan, discloses substantially all of the limitations of claim 13, but does not disclose the program data as a compressed MPEG data, as in claim 13. The reference, Barrett, discloses a video broadcasting system compressing video in to MPEG form in column 4, lines 41-47. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compressed signal of the reference Ryan, to be in MPEG form, as disclosed by Barrett, in order to achieve better compression and to conserve less storage area.

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15. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogalski (U.S. 5,159,636) applied to claim 29 above, and further in view of Barrett (U.S. 5,287,420)

The reference, Rogalski, discloses substantially all of the limitations of claim 30, but does not disclose a MPEG decoder, as in claim 30. The reference, Barrett, discloses MPEG decoder in Fig. 1, represented by 23. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the decompressor of the reference, Ryan, to be a MPEG decoder, as disclosed by Barrett, in order to achieve better decompression.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Culin (U.S. 5,020,104) is cited to show a frequency converter.

Bialick (U.S. 4,864,620) is cited to show a method for performing time-scale modification of speech information.

Asada et al. (U.S. 4,435,832) is cited to show a speech synthesizer having time stretch and compression functions.

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Goldwasser et al. (U.S. 4,908,866) is cited to show a variable delay period between recording and replaying.

Schiffman (U.S. 3,786,195) is cited to show a variable delay line signal processor for sound reproduction).

17. Any inquiry of a general nature relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-4700**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seema S. Rao whose telephone number is (703) 308-5463.

SSR

Seema S. Rao

September 19, 1996

Alpus H. HSU

**ALPUS H. HSU
PRIMARY EXAMINER
GROUP 2600**



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
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DATE MAILED:

NOTICE OF INFORMAL APPLICATION

(Attachment to Office Action)

This application does not conform with the rules governing applications for the reason(s) checked below. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A. A new oath or declaration, identifying this application by the application number and filing date is required. The oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or foreign country of residence of each inventor.
2. ☐ does not identify the citizenship of each inventor.
3. ☐ does not state whether the inventor is a sole or joint inventor.
4. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ believes the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
 - c. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
5. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
6. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).
7. ☐ does not include the date of execution.
8. ☐ does not use permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).
9. ☐ contains non-initialed alterations (See 37 CFR 1.52(c)).
10. ☐ Other:

B. Applicant is required to provide:

1. ☐ A statement signed by applicant giving his or her complete name. A full name must include at least one given name without abbreviation as required by (37 CFR 1.41(a)).
2. ☐ Proof of authority of the legal representative under 37 CFR 1.44.
3. ☐ An abstract in compliance with 37 CFR 1.72(b).
4. ☐ A statement signed by applicant giving his or her complete post office address (37 CFR 1.33(a)).
5. ☐ A copy of the specification written, typed, or printed in permanent ink, or its equivalent in quality as required by 37 CFR 1.52(a).
6. ☐ Other: *Claim are Miss Number*